

REMARKS

Summary of the Office Action

In the Office Action, claim 1 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the Applicant's Admitted Prior Art ("*APA*").

Claim 1 is rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by Japanese Patent No: JP-403079519A to *Ishihara*.

Claims 1-5, 11, and 18 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Japanese Patent No: JP-06247569A to *Ohashi*.

Claims 1-5, 11, and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi*.

Claims 1-5, 11, and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of the *APA*.

Claims 6 and 12 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of *Ishihara*.

Claim 10 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of Japanese Patent No: JP-2000122362A to *Ishio et al.* ("*Ishio*").

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the features of the base claim and any intervening claims.

Summary of the Response to the Office Action

Applicants amend claims 1, 11, and 18 to better clarify the meaning of the claims. Applicants add claims 19-20 to recite particular features of independent claim 1 in dependent form. Applicants add claims 21-22 to provide an alternate scope of protection. Claims 8-9 are withdrawn. Claims 13-17 are cancelled without prejudice or disclaimer. Accordingly, claims 1-7, 10-12, and 18-22 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claim 1 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Applicant's Admitted Prior Art ("*APA*"). This rejection is respectfully traversed.

Applicants respectfully submit that the Office Action has not established that the *APA* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites "the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said transport path is exposed by opening at least one of the plurality of openable covers." The *APA* only discloses features of "conventional apparatuses include a paper transport path on a lateral side of the apparatus, and therefore the paper path provided along the side surface of the apparatus must be opened to remove a sheet stuck in the path upon a paper jam," as stated in the specification at page 4, lines 15-18.

The Office Action also asserts that the tray of the *APA* is movable in two directions, in and out. However, the Office Action does not consider that the tray in the present invention moves in, out, left, and right. Newly amended claim 1 now recites a "sheet storing portion

comprising at least one sheet tray that stores a stack of recording sheets and is horizontally movable in two directions, which intersect with each other.” Emphasis added. As such, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because the *APA* does not teach or suggest each feature of independent claim 1.

Claims 1-5, 11 and 18 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by *Ohashi*. This rejection is respectfully traversed.

Applicants respectfully submit that the Office Action has not established that *Ohashi* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites “the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said transport path is exposed by opening at least one of the plurality of openable covers.” At least these features are not disclosed or taught by *Ohashi*.

The Office Action asserts that *Ohashi* discloses features of the cover similar to that shown by part 111 in Figs. 25 and 26. Applicants respectfully disagree. Part 111 is not a cover, but actually is a manual paper feed portion for inserting paper into the imaging apparatus. A machine translation of JP 06-247569 A from the Japanese Patent Office (JPO) indicates that part 111 as shown in Fig. 25 is the [pressure plate and 111] of the manual bypass sections. See ¶ 0002 of the attached JPO machine translation. Further, part 111 is not located “on a front side wall thereof” of the main body of the image forming apparatus as recited in claim 1. Claim 1 is amended to better clarify where the front side of the image forming apparatus is located.

Therefore, *Ohashi* does not disclose the cover on a front side wall and cannot anticipate the invention recited in claim 1.

The Office Action also points to the unnumbered rectangle on the front surface of Fig. 1 of *Ohashi* as being the recited openable cover. The JPO machine translation of the specification does not discuss or even mention this feature. The comments in the Office Action make the unsubstantiated assertion that the unnumbered rectangle on the front surface of Fig. 1 is a cover as recited in the claims. Neither the figure nor the translation discloses the purpose of the unnumbered rectangle, therefore Applicants respectfully submit that these unsubstantiated assertions cannot be considered to be anticipatory of the present invention.

Further, Applicants respectfully submit that independent claim 11 recites “said transport path is provided to run from one tray and penetrate through the other trays in the vertical direction,” and at least these features are not disclosed, taught, or suggested by *Ohashi*. *Ohashi* does not show the transport path running through trays stacked in a vertical direction. Because *Ohashi* does not disclose this, it cannot anticipate the invention recited in claim 11.

Applicants respectfully submit that the Office Action has not established that *Ohashi* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 11 recites “the direction in which the sheet tray is pulled out coincides with the direction in which said recording sheets are fed, and the sheet tray is movable in two directions substantially orthogonal to each other.” At least these features are not disclosed or taught by *Ohashi*.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Ohashi* does not teach or suggest each feature of independent claims 1 and 11.

Additionally, Applicants respectfully submit that dependent claims 2-5 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 1-5, 11, and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi*. As demonstrated above, the Office Action has not established a *prima facie* case of obviousness at least because *Ohashi*, whether alone or in combination, does not teach or suggest all the recited features of independent claims 1 and 11.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Ohashi* does not teach or suggest each and every feature of independent claims 1 and 11.

Additionally, Applicants respectfully submit that dependent claims 2-5 and 18 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 11, as well as reciting additional features that further distinguish over the applied prior art.

Claims 1-5, 11, and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of the *APA*. As demonstrated above, the Office Action has not established a *prima facie* case of obviousness at least because *Ohashi*, whether alone or in combination, does not teach or suggest all the recited features of independent claims 1 and 11. Specifically, the covers allegedly taught by the *APA* in Fig. 22 are actually shown on the side wall of the image forming apparatus and not on a front side wall as recited in independent claim 1.

Further as demonstrated above, Applicants respectfully submit that independent claim 11 recites “said transport path is provided to run from one tray and penetrate through the other trays in the vertical direction,” and at least these features are not taught or suggested by *Ohashi* or the *APA*. Because neither *Ohashi* nor the *APA* teach or suggest these features, it cannot make obvious the present invention as recited in claim 11.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because

Ohashi and the *APA*, whether combined or alone, do not teach or suggest each and every feature of independent claims 1 and 11.

Additionally, Applicants respectfully submit that dependent claims 2-5 and 18 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 11, as well as reciting additional features that further distinguish over the applied prior art.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ohashi* in view of *Ishihara*. This rejection is respectfully traversed.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under "no obligation to submit evidence of nonobviousness," such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Applicant.

In order to establish a *prima facie* case of obviousness, the Office must satisfy three requirements. M.P.E.P. § 2142. First, "the prior art reference, or references when combined, must teach or suggest *all* the claim limitations." *Id.* (emphasis added). Second, the Office must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." *Id.* Finally, "there must be a reasonable expectation of success." *Id.*

In the present case, neither *Ohashi* nor *Ishihara*, either alone or in combination teaches or

suggests at least the feature of “the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said transport path is exposed by opening at least one of the plurality of openable covers,” as recited in claim 1, and the feature of “[a]n image forming apparatus . . . wherein . . . the sheet tray is movable in two directions substantially orthogonal to each other,” as recited in newly amended claim 11, from which claims 6 and 12 depend, respectively.

With respect to claim 6, *Ishihara* does not make up for the deficiencies of *Ohashi*. That is, *Ishihara* does not teach or suggest an image forming apparatus with a plurality of openable covers on a front side wall as recited in claim 1. Thus, the Office Action has not established a *prima facie* case of obviousness at least because neither *Ohashi* nor *Ishihara*, whether alone or in combination, teach or suggest all the recited features of independent claim 1 from which claim 6 depends.

Further, *Ishihara* also does not make up for the deficiencies of *Ohashi* because *Ishihara* does not teach or suggest an image forming apparatus with a “sheet storing portion comprising at least one sheet tray that stores a stack of recording sheets and is horizontally movable in two directions, which intersect with each other,” as in newly amended claim 1. Thus, the Office Action has not established a *prima facie* case of obviousness at least because neither *Ohashi* nor *Ishihara*, whether alone or in combination, teach or suggest all the recited features of independent claim 1 from which claim 6 depends.

With respect to claim 12, *Ishihara* does not make up for the deficiencies of *Ohashi*. That is, *Ishihara* does not teach or suggest “[a]n image forming apparatus . . . wherein . . . the sheet

tray is movable in two directions substantially orthogonal to each other,” as recited in newly amended independent claim 11. Thus, the Office Action has not established a *prima facie* case of obviousness at least because neither *Ohashi* nor *Ishihara*, whether alone or in combination, teach or suggest all the recited features of independent claim 11, from which claim 12 depends.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Because the Office Action fails to meet at least one of the three requirements for establishing a *prima facie* case of obviousness, Applicants respectfully request that the rejection of claims 6 and 12 under 35 U.S.C. § 103(a) be withdrawn.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of *Ishio*. This rejection is respectfully traversed.

Applicants respectfully submit neither *Ohashi* nor *Ishio*, either alone or in combination teaches or suggests at least the features of “the main body of the image forming apparatus comprises a plurality of openable covers on a front side wall thereof, and at least a part of said transport path is exposed by opening at least one of the plurality of openable covers,” as recited in claim 1, from which claim 10 depends. Claim 1 is amended to positionally relate the front side of the image forming apparatus. Thus, the Office Action fails to establish a *prima facie* case of obviousness as to claim 10.

Ishio does not make up for deficiencies previously demonstrated in *Ohashi*. Accordingly,

it is respectfully submitted that the rejection is in error. Withdrawal of the rejection under 35 U.S.C. § 103(a) over *Ohashi* in view of *Ishio* is respectfully requested. Claim 10 is also allowable at least because it recites the same combination of features as independent claim 1, as well as the additional features it recites that further distinguish them over the applied art.

Further, *Ishio* also does not make up for the deficiencies of *Ohashi* because *Ishio* does not teach or suggest an image forming apparatus with a “sheet storing portion comprising at least one sheet tray that stores a stack of recording sheets and is horizontally movable in two directions, which intersect with each other,” as in newly amended claim 1. Thus, the Office Action has not established a *prima facie* case of obviousness at least because neither *Ohashi* nor *Ishio*, whether alone or in combination, teach or suggest all the recited features of independent claim 1 from which claim 10 depends.

For the same reasons above-mentioned, it is respectfully submitted that none of the references of record teach or suggest the features of Applicants pending claims. In view of the above arguments, Applicants respectfully request that the rejection of claim 10 under 35 U.S.C. §103(a) be withdrawn.

New Claims 19-22

Applicants respectfully submit that dependent claims 19-20 are also allowable insofar as they recite the patentable combinations of features recited in newly amended claim 1, as well as reciting additional features that further distinguish over the applied prior art. Applicants add claims 21-22 to provide an alternate scope of protection.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and allowance of all pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.


EXCEPT for issue fees payable under 37 C.F.R. § 2.28, the Commission is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to to our Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: August 22, 2006

By:


Mary Jane Boswell
Reg. No. 33,652

CUSTOMER NO. 09629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: (202) 739-3000
Facsimile: (202) 739-3001